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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,332	09/30/2003	Atsushi Sugasaki	Q77298	2251
23373	7590	07/28/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			LEE, SIN J	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/673,332

Applicant(s)

SUGASAKI ET AL.

Examiner

Sin J. Lee

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. It is to be noted that the PTO/SB/08 Form filed by applicants with the IDS on February 2, 2004 is missing from the file. Thus, the Examiner respectfully requests the applicants to send a copy of the PTO/SB/08 Form submitted on February 2, 2004 with the next response.

2. Applicants canceled claims 15-20.

3. In view of the amendment of May 2, 2005, previous 102(b) rejection on claims 1-20 over Oshima (EP 1 176 467 A1) is hereby withdrawn. Oshima does not teach or suggest present repeating unit of formula (A) or (C).

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

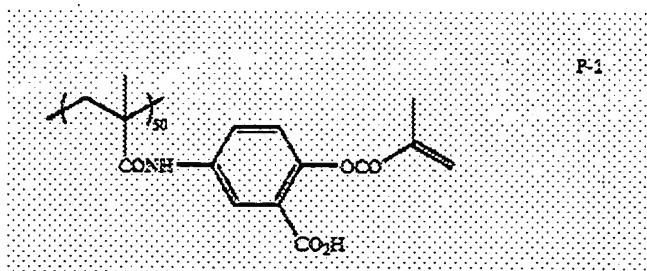
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

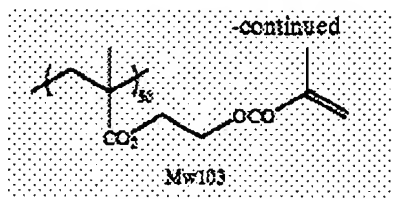
6. Claims 1-14, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kunita et al (US 2004/0068026 A1)

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In Example 1 (see Table 2 and [0295]), Kunita teaches a polymerizable composition containing a binder polymer P-1, a polymerization initiator, a sensitizing dye (infrared absorbent – see [0163]) and a polymerizing compound. The structure for the binder polymer P-1 is shown below:





The first repeat unit of the binder P-1 teaches present repeat unit of formula (I) (in present formula (I), A would be -NH- , and R^2 would be a linking group of $\text{-C}_6\text{H}_3\text{-OCO-C(=CH}_2\text{)-CH}_3$ which has 20 atoms). The second repeat unit of the binder P-1 teaches present repeat unit having a radical-polymerizable group of formula (A). Thus, the prior art teaches present inventions of claims 1-4 and 21.

With respect to present claim 5, Kunita states in [0072] that the T_g of his polymerizable polymer is preferably in a range of 70 to 300°C. Thus, the prior art teaches present invention of claim 5.

Kunita coats his polymerizable composition onto an aluminum plate to form a recording layer (see [0295]). Then, the recording layer is subjected to scanning exposure with a laser (such as a 400 nm semiconductor laser, 532 nm FD-YAG laser, and 830 nm semiconductor laser) and to development (see [0308]). Therefore, the prior art teaches present inventions of claims 6, 8 and 22.

With respect to present claim 7, Kunita teaches that his polymerizable composition preferably further contains a polymerizable crosslinking agents having a Mw of 1,000 to 10,000, and as examples of such crosslinking agents, Kunita includes binders having an acrylic backbone-chain (see (Q1) to (Q-26) of [0086]). Thus, the prior art teaches present invention of claim 7.

As one of examples for his polymerization initiator, Kunita teaches a sulfonium salt such as the one shown in [0302] as X-3. Thus, the prior art teaches present inventions of claims 9 and 10. Also, Kunita teaches [0162]) that the preferable amount for his polymerization initiator is 0.1-2% by mass. Therefore, the prior art teaches present invention of claim 11.

Kunita teaches ([0097]) that the amount of his polymerizable compound is preferably 20% by mass or less. Thus, the prior art teaches present invention of claim 12.

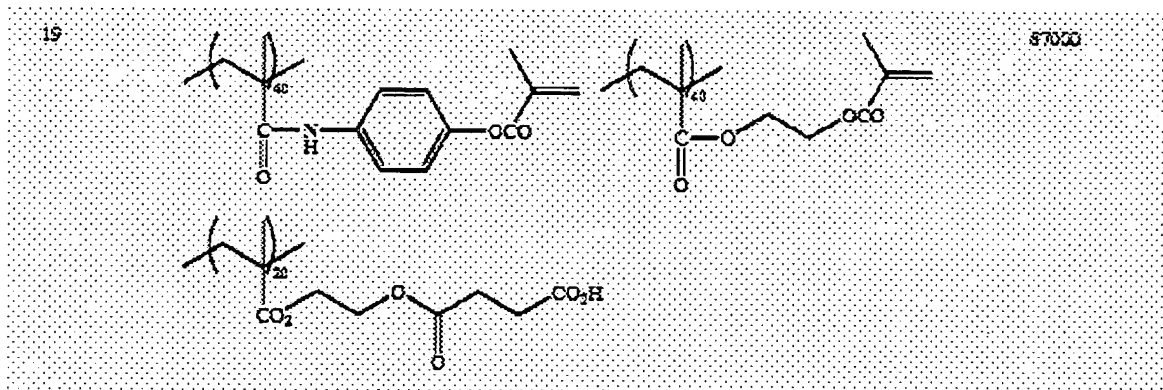
Kunita teaches ([0225] and [0226]) the use of a thermal polymerization inhibitor such as hydroquinone. Therefore, the prior art teaches present inventions of claims 13 and 14.

7. Claims 1-6, 8-14, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Fujimaki (US 2004/0234893 A9)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In Example 12 (see Table 14 and [0480]), Fujimaki teaches a polymerizable composition containing Polymer compound 19, a radical-polymerizing compound,

infrared absorbent, and a radical generating agent. The structure for the Polymer compound 19 is shown below:



The third repeat unit of the polymer teaches present repeat unit of formula (I) (present A being an oxygen atom, and present R² being a linking group of -CH₂-CH₂-O-C(=O)-CH₂-CH₂- having 15 atoms), and the first repeat unit teaches present repeat unit having a radical-polymerizable group of formula (A).

Fujimaki applies his composition onto an aluminum support, and the resultant planographic printing plate precursor is exposed with infrared semiconductor laser and then developed (see [0479], [0482], and [0483]). Also, in [0152], Fujimaki states that the T_g for his resin is preferably 80°C or more. Therefore, the prior art teaches present inventions of claims 1-6, 8, 21, and 22.

In Example 12, Fujimaki uses a sulfonium salt (S-3) as his radical generating agent (see [0449]). Thus, the prior art teaches present inventions of claims 9 and 10.

Fujimaki teaches the use of his radical generating agent in the amount of 0.1 to 50 mass% (see [0304]). Thus, the prior art teaches present invention of claim 11.

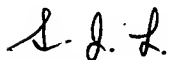
Fujimaki teaches ([0379]) the use of his radical-polymerizable compound in the amount of 5 to 80 mass %. Thus, the prior art teaches present invention of claim 12.

Furthermore, Fujimaki teaches ([0387]) the use of a thermal polymerization inhibitor such as hydroquinone. Therefore, the prior art teaches present inventions of claims 13 and 14.

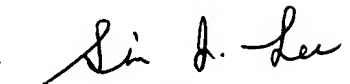
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee
July 24, 2005


SIN LEE
PRIMARY EXAMINER